



## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

[Docket No.: PTO-P-2022-0001]

### Extension of, and New Combined Petition Option for Participation in, the Expanded Collaborative Search Pilot Program

**AGENCY:** United States Patent and Trademark Office, Department of Commerce.

**ACTION:** Notice.

**SUMMARY:** To speed up patent examination and give applicants more comprehensive prior art by combining the search expertise of United States Patent and Trademark Office (USPTO), Japan Patent Office (JPO), and Korean Intellectual Property Office (KIPO) examiners before issuing a first Office action, the USPTO, in partnership with the JPO and the KIPO, is extending the Expanded Collaborative Search Pilot (CSP) program for an additional two years, through October 31, 2024. Requests to participate in the Expanded CSP program that were filed between October 31, 2022, and [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER], will be considered.

In addition, the partner intellectual property (IP) offices have collaborated on a new petition option for participation in the Expanded CSP program. The new petition option, which has several enhancements compared to the current petition form and process, permits an applicant to file a combined petition in either the USPTO or one of the partner IP offices rather than separate petitions in each office. Enhancements include a more user-friendly layout, the addition of multilingual text, and a foundation for data collection that both satisfies the petition requirements and streamlines the process for partaking in the Expanded CSP program.

**DATES:** *Pilot duration:* The Expanded CSP program will continue until October 31, 2024. Each partner IP office will continue to grant no more than 400 requests per year per partner office for the duration of the pilot.

*New petition option applicability date:* The combined petition option and the related process will take effect on **[INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

**FOR FURTHER INFORMATION CONTACT:** You may direct inquiries regarding any specific application participating in the pilot to Jessica Patterson; Senior Advisor and Director; International Worksharing, Planning, and Implementation; Office of International Patent Cooperation; at 571-272-8828 or Jessica.Patterson@uspto.gov. You may email any inquiry regarding this pilot program and the petition process to csp@uspto.gov. You may direct inquiries concerning this notice to Michael Arguello; Management and Program Analyst; International Worksharing, Planning, and Implementation; Office of International Patent Cooperation; at 571-270-7876 or Michael.Arguello@uspto.gov.

## **SUPPLEMENTARY INFORMATION:**

### **I. Background**

The USPTO continually looks for ways to improve its worksharing pilot programs, including the Expanded CSP program. The Expanded CSP program provides applicants who cross-file with the USPTO and the JPO or the KIPO with search results from each partner IP office early in the examination process. It is designed to accelerate examination and provide the applicant with more comprehensive prior art by combining the search expertise of the USPTO and the JPO or the KIPO examiners before issuing a first Office action. For additional details about this program, *see* Expanded Collaborative Search Pilot Program Extension, 86 FR 8183 (February 4, 2021) (Expanded CSP extension notice). Feedback from applicants based in the United States, Korea, and Japan

has cited the petition process as an area for improvement, specifically the requirement to petition each partner IP office separately. As a result, the USPTO collaborated with its partner IP offices, the JPO and the KIPO, to develop combined petition forms (PTO/437-JP for the USPTO/JPO pilot program and PTO/437-KR for the USPTO/KIPO pilot program). Submitting a completed combined petition form to either the USPTO or the partner IP office (the JPO or the KIPO) will result in receipt of the form at both offices in the corresponding pilot program and placement in the application files of both counterpart applications.

The current petition option and process, in which an applicant files a separate petition or a request with each partner IP office (original petition option), remains available. Under the original petition option, an applicant must submit petition form PTO/SB/437 (without the JP or KR designation) to the USPTO to request CSP participation for the U.S. application and must make a separate submission to the partner IP office in the desired pilot to request CSP participation for a counterpart application.

## **II. Overview of the Combined Petition Option**

Applicants need only submit one combined petition form to the USPTO or the partner IP office (the JPO or the KIPO). There are separate agreements between the USPTO and the JPO and the USPTO and the KIPO. Therefore, to request participation in the corresponding pilot program between the USPTO and the JPO using this combined petition option, applicants must file the combined petition form PTO/437-JP with either the USPTO or the JPO. Likewise, to request participation in the corresponding pilot program between the USPTO and the KIPO using this combined petition option, applicants must file the combined petition form PTO/437-KR with either the USPTO or the KIPO. However, if an application corresponds to more than one application in a partner IP office, the combined petition option cannot be used. In this situation, an

applicant must use the original petition option (form PTO/SB/437, without the JP or KR designation) to request participation in the Expanded CSP program.

Under the combined petition option, use of the proper combined petition form will assist applicants in complying with the pilot program's requirements and will assist the USPTO in quickly identifying participating applications and their corresponding partner IP office. The combined petition forms for the USPTO/JPO pilot program and the USPTO/KIPO pilot program are multilingual. Both combined petition forms provide links to the requirements (with exceptions noted in section VI below) and conditions for entry into the respective pilot program for each partner IP office. As each partner IP office's conditions for entry may differ, applicants should review the requirements of the relevant partner IP offices to ensure compliance.

Forms PTO/437-JP and PTO/437-KR are available as Portable Document Format (PDF) fillable forms at the USPTO's CSP website at [www.uspto.gov/CollaborativeSearch](http://www.uspto.gov/CollaborativeSearch). The forms can also be accessed at the USPTO website at [www.uspto.gov/PatentForms](http://www.uspto.gov/PatentForms). The Office of Management and Budget (OMB) has reviewed and approved the collection of information involved in this pilot program, under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.), as part of a collection identified by OMB control number 0651-0079. Collection 0651-0079 is available at OMB's Information Collection Review website, [www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain). No fee for the combined petition to make special under 37 CFR 1.102 is required for participation in the Expanded CSP program.

### **III. Filing a Combined Petition Form**

If opting to use a combined petition form, applicants must file a completed combined petition form (PTO/437-JP or PTO/437-KR) for each pilot program in which the applicant wishes to participate.

Combined petition form PTO/437-JP must either be directly filed in the U.S. application or directly with the JPO for the USPTO/JPO pilot program, and combined petition form PTO/437-KR must either be directly filed in the U.S. application or directly with the KIPO for the USPTO/KIPO pilot program. If the combined petition form is directly filed in the U.S. application, the applicant must file it using either USPTO filing system(s) or Patent Center. If the applicant directly files the combined petition form with the partner IP office, the combined petition form must be accompanied by supporting documents (e.g., an English translation of the claims of the application filed in the partner IP office; a machine translation of the claims is acceptable). The corresponding partner IP office will then transmit the combined petition form and supporting documents to the USPTO. The applicant should not file the combined petition form directly with both the USPTO and the corresponding partner IP office.

Based on the agreements between the USPTO and the partner IP offices, if the applicant directly files the combined petition form with the USPTO, then the USPTO must transmit the completed form and any accompanying supporting documents, along with the date of receipt, to the corresponding partner IP office. Additionally, if the applicant files the combined petition form directly with the JPO or the KIPO, then the partner IP office that receives the filing must transmit the form and the accompanying supporting documents, along with its date of receipt, to the USPTO. The USPTO will then place the combined petition form and the accompanying supporting documents in the file of the U.S. application. Incomplete combined petition forms will not be forwarded to the corresponding partner IP office and will be dismissed in accordance with the Memorandums of Cooperation between the USPTO and the respective partner IP offices.

Under the combined petition option, the partner IP offices have agreed to transmit the combined petition form to the corresponding partner IP office within 15 days of

receipt from the applicant. This reduces the risk of the counterpart application being acted upon by an examiner in the partner IP office before that application enters the pilot program, which would result in both applications being denied entry into the Expanded CSP program. The request for participation in the Expanded CSP program must be granted by both the IP office in which the request is directly filed and the partner IP office prior to any examination of the counterpart applications in either office.

To the extent that the combined petition form forwarded to the USPTO from a partner IP office does not comply with the requirements of 37 CFR 1.4(d)(2) and (d)(3), and 1.6(a), these requirements are waived for certain elements. Specifically, with respect to 37 CFR 1.4(d)(2), a forwarded combined petition form containing an S-signature will not be required to be filed by facsimile transmission, via the USPTO patent electronic filing system (i.e., USPTO filing system(s) or Patent Center), or on paper. With respect to 37 CFR 1.4(d)(3), a forwarded combined petition form containing a graphic representation of a handwritten signature or an S-signature will not be required to be filed via the USPTO patent electronic filing system. With respect to 37 CFR 1.6(a), a forwarded combined petition form will be accorded a receipt date even though it was not received at the USPTO by mail, filed via the USPTO patent electronic filing system, or hand-delivered to the USPTO. The U.S. receipt date of the combined petition form will either be the actual date that the combined petition form is received at the USPTO via the USPTO patent electronic filing system or the date the combined petition form is transmitted to the USPTO from the partner IP office, which may not be the same as the receipt date in the partner IP office.

#### **IV. Requirements for Participation in the Expanded CSP**

To be accepted into the Expanded CSP program, applicants who use the combined petition option must meet all the requirements of the pilot program that are set forth in

section III of the Expanded CSP extension notice, except with the following modifications.

Under the combined petition option, the combined petition form PTO/437-JP or PTO/437-KR must be used instead of form PTO/SB/437, and the combined petition form, as discussed above, must be submitted to either the USPTO or the partner IP office (the JPO or the KIPO). Separate petitions are not required to be filed in both the USPTO and the partner IP office. The combined petition form PTO/437-JP or PTO/437-KR also includes an express written consent under 35 U.S.C. 122(c) for the USPTO to receive the combined petition form (if filed directly with the corresponding partner IP office) and to accept and consider prior art references and comments from the designated partner IP office during the examination of the U.S. application. In addition, the combined petition form includes written authorization for the USPTO to forward the form (if filed directly with the USPTO) to the corresponding partner IP office and to provide to the designated partner IP office, before a first Office action on the merits, access to the participating U.S. application's bibliographic data and search results, in accordance with 35 U.S.C. 122(a) and 37 CFR 1.14(c). No other consents are required.

#### **V. Treatment of a Combined Petition Form**

The combined petition form filed directly or indirectly in the U.S. application will be treated in the manner set forth in section IV of the Expanded CSP extension notice.

#### **VI. Requirement for Restriction**

The requirement for restriction set forth in section V of the Expanded CSP extension notice remains the same for the combined petition option.

#### **VII. First Action on the Merits**

Under the Expanded CSP program, the USPTO examiner will consider all exchanged search results. However, search results that are not received by the USPTO within four months from the date the USPTO granted the petition may not be included in

the first action on the merits (FAOM). The examiner will prepare and issue an Office action and notify the applicant if any designated partner IP office did not provide search results prior to the issuance of the Office action. Once an FAOM issues, the application will no longer be treated as special under the Expanded CSP program.

The USPTO will continue to cooperate with applicants, IP stakeholders, and partner IP offices to improve the CSP process. More information on the CSP is available at [www.uspto.gov/CollaborativeSearch](http://www.uspto.gov/CollaborativeSearch).

**Katherine K. Vidal,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

[FR Doc. 2023-00799 Filed: 1/17/2023 8:45 am; Publication Date: 1/18/2023]